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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PATTERSON, MARC A

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 03/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/004,874	SWOBODA ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Marc A Patterson	1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 07 December 2001.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-16 and 21-29 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-16 and 21-29 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 – 16 and 21 – 29, drawn to a high gloss paperboard / container, classified in class 428, subclass 34.1.
  - II. Claims 17 – 20, drawn to a method of making a high gloss paperboard container, classified in class 156, subclass 79.
  - III. Claims 30 – 35, drawn to a method of improving the wet rigidity of a disposable food container, classified in class 156, subclass 150.
2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a materially different process, such as one in which the paperboard is cut and scored following heat pressing.
3. Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the

product can be made by a materially different process, such as one in which no clay coating layer is applied.

4. Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it is not necessary for the paperboard food container to have improved wet rigidity. The subcombination has separate utility such as a food container in which improved wet rigidity is necessary.

5. Because these inventions are distinct for the reasons described above, and have acquired a separate status in the art because of their recognized different classification and subject matter, and because the searches required for the groups are not the same, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Mr. Michael Ferrell on January 31, 2003, a provisional election was made without traverse to prosecute the invention of I, claims 1 – 16 and 21 – 29. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17 – 20 and 30 – 35 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1 – 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to Claim 1, the phrase 'formed in a heated die set from a paperboard blank' is indefinite as its meaning is unclear. The phrase also appears to be directed to a method limitation, which is given little patentable weight as discussed below. For purposes of examination, the phrase will be assumed to mean that the container comprises a paperboard blank. The phrase 'being prepared from a paperboard substrate' is also indefinite as its meaning is unclear. The phrase also appears to be directed to a method limitation, which is given little patentable weight as discussed below. For purposes of examination, the phrase will be assumed to mean that the blank comprises a paperboard substrate. The phrase 'as measured by ASTM D523-89' is indefinite as the abbreviation denotes a standard, which may change with time. The phrase '60 degrees' is indefinite, as no temperature scale has been defined. For purposes of examination, the gloss will be assumed to be any gloss. The term "high" in claim 1 is a relative term which renders the claim indefinite. The term "high" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term "glossy" in claim 1 is a relative term which renders the claim indefinite. The term "glossy" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite

degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

9. Claims 21 – 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to Claim 21, the phrase 'as measured by ASTM D523-89' is indefinite as the abbreviation denotes a standard, which may change with time. The term "high" in claim 1 is a relative term which renders the claim indefinite. The term "high" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term "glossy" in claim 1 is a relative term which renders the claim indefinite. The term "glossy" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

10. Claims 4 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase 'are waterborne compositions' is indefinite as its meaning is unclear. The phrase also appears to be directed to a method limitation, which is given little patentable weight as discussed below. For purposes of examination, the phrase will be assumed to mean any composition.

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11. Claims 14 – 15 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to Claims 14 – 15, the phrase ‘prior to being coated’ is indefinite as its meaning is unclear. The phrase also appears to be directed to a method limitation, which is given little patentable weight as discussed below. For purposes of examination, the phrase will be assumed to mean that the clay coating is between the first coating and paperboard.

12. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase ‘are maintained at a heated temperature’ is indefinite as its meaning is unclear. The phrase also appears to be directed to a method limitation, which is given little patentable weight as discussed below. Claim 16 recites the limitation "during pressing" in line 3. There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1 – 4, 10 – 13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Shanton (U.S. Patent No. 5,776,619).

With regard to Claims 1 – 3, Shanton discloses a paperboard food container (disposable tray; column 1, lines 11 – 17) comprising a paperboard blank (plate stock; column 4, lines 1 – 5) provided with a first coating layer comprising a styrene – butadiene resin (column 4, lines 30 – 36; column 5, lines 25 – 32) and a second top coating layer comprising an acrylic resin applied to the first layer (therefore a bilayer finish; column 4, lines 30 – 36); the food container exhibits a surface gloss (gloss; column 8, lines 5 – 14) of 74.8 (therefore at least 40; column 8, lines 5 – 14). With regard to the aspect in Claim 1 of the container being ‘formed in a heated die set,’ and with regard to Claims 4 and 16, the scope of the claims falls within the limitations of Shanton as discussed above. The method of application of the coating to the paperboard (product – by – process) is given little patentable weight. Applicant would need to demonstrate, by verified showing, the unexpected advantages accruing from the methods of coating application as claimed.

With regard to the claimed aspect of the first coating layer ‘consisting essentially of’ styrene butadiene, and the second layer ‘consisting essentially of’ acrylic resin, the use of ‘consisting essentially of’ language does not deem the claims patentable over Shanton. When an applicant claims that additional materials are excluded by the recitation ‘consisting essentially of,’ applicant has the burden of showing that the introduction of additional components would materially change the characteristics of applicant’s invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964) ; *In re Herz*, 537 F2d. 549, 551 – 552, 190 USPQ 461, 463 (CCPA 1976).

With regard to Claim 10, Shanton teaches styrene – butadienes as the material of the first coating (column 5, lines 24 – 35). The claimed aspect of the coating comprising a ‘carboxylated styrene – butadiene’ therefore reads on Shanton.

With regard to Claims 11 – 13, the paperboard has a basis weight from 100 to 300 pounds per 3,000 square feet (column 4, lines 15 – 20).

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 5 – 9, 14 – 15 and 21 – 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanton (U.S. Patent No. 5,776,619).

Shanton discloses a styrene – butadiene coated paperboard for making a food container as discussed above. With regard to Claims 5 – 9 and 23 – 29, Shanton fails to disclose a coating which is applied in an amount from 0.25 to 1.5 pounds per 3,000 square foot ream. However, Shanton discloses a coating which is applied in an amount from 4 to 12 pounds per 3,000 square foot ream (column 4, lines 1 – 13). Therefore, the coating weight would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end use of the product. It therefore would be obvious for one of ordinary skill in the art to vary the coating weight, since the coating weight would be readily determined through routine

optimization by one having ordinary skill in the art depending on the desired end result as shown by Shanton. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

With regard to Claims 14 – 15 and 21 – 22, the paperboard is provided with one or more clay coatings between the first coating and the paperboard (one or more coatings of the first coating is used, and the first coating comprises clay; column 4, lines 5 – 8 and lines 30 – 36). Shanton fails to disclose a paperboard which is sized with at least 4 to 15 pounds per 3,000 square feet of starch. However, Shanton discloses a paperboard which is sized with at least a fraction of a pound per 3,000 square feet of starch (the paperboard is sized with starch; column 6, lines 15 – 17). Therefore, the amount of starch would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end use of the product. It therefore would be obvious for one of ordinary skill in the art to vary the amount of starch, since the amount of starch would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Shanton. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

### ***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Patterson, whose telephone number is (703) 305-3537. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Harold

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Pyon, can be reached at (703) 308-4251. FAX communications should be sent to (703) 872-9310. FAXs received after 4 P.M. will not be processed until the following business day.

Marc A. Patterson, PhD.

*Marc Patterson*  
Art Unit 1772

*Harold Pyon*  
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SUPERVISORY PATENT EXAMINER  
*1772*

3/24/03